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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JAMES PANYARD et al.

Serial No.: 10/709,775

Filed: May 27, 2004

For: HOSE CLAMP TOOL

Attorney Docket No.: 81096680 (FMC 1705 PUS)

Group Art Unit: 3723

Examiner: Shantese L. McDonald

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal Brief from the final rejection of claims 1, 2, 15, 16, 18 and 19 of the Office Action mailed on October 4, 2005 for the above-identified patent application.

I. REAL PARTY IN INTEREST

The real party in interest is Ford Motor Company ("Assignee"), a corporation organized and existing under the laws of the state of Delaware, and having a place of business at The American Road, Dearborn, MI 48121, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on May 27, 2004 at Reel 014664/Frame 0266.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (FIRST CLASS MAIL)

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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Name of Person Signing

Matthew M. Mietzel
Signature

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to the Appellant, the Appellant's legal representative, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-20 are pending in this application. Claims 9-14 have been allowed. Claims 3-8, 17 and 20 are objected to as being dependent on a rejected base claim. Claims 1, 2, 15, 16, 18 and 19 have been rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

All amendments previously filed in this application have been entered. No amendment after the final rejection was filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to a hose clamp installation tool (30,130). The hose clamp installation tool (30,130) includes a housing (32, 132) having a distal end, a tab (42,142) disposed on the distal end for engaging a clamp (20), an engagement surface (48, 144), and a sensor (36,136). The engagement surface (48,144) is fixedly positioned relative to the tab (42,142) for engaging the clamp (20) to release the clamp (20) from an open position (shown in Figures 1, 3, and 4) and allow the clamp (20) to shift to a closed position (shown in Figure 5). The sensor (36, 136) detects the shifting of the clamp (20). (See paragraphs [0025]-[0039] and [0045].)

A second expression of the invention also relates to a hose clamp installation tool (30,130). The hose clamp installation tool (30,130) includes a housing (32,132) having a distal end, an arm (34,134) disposed on the distal end, and a sensor (36,136). The arm (34,134) includes a tab (42,142) and an engagement surface (48,148) disposed adjacent to the

tab (42,142), the engagement surface (48,148) being adapted to contact the clamp (20) to release the clamp (20) from an open position (shown in Figures 1, 3, and 4) and allow the clamp to shift to a closed position (shown in Figure 5). The sensor (36,136) provides a signal indicative of the shifting of a clamp (20) from the open position to the closed position. (See paragraphs [0025]-[0039] and [0045].)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 15, 16, 18 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,907,802 issued to Schneider.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,802 issued to Schneider in view of U.S. Patent No. 5,615,575 issued to Goodwin.

VII. ARGUMENT

A. Claims 1, 15, 16, 18 and 19 Are Patentable Under 35 U.S.C. § 102(b) Over U.S. Patent No. 5,907,802 issued to Schneider

U.S. Patent No. 5,907,802 issued to Schneider (hereinafter “Schneider ‘802”) does not anticipate claims 1, 15, 16, 18 and 19. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is “inherent” in its disclosure. To establish inherency, the extrinsic evidence must

make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

A *prima facie* case has not been established for the rejection of independent claim 1. Claim 1 recites a hose clamp installation tool. The tool includes “a housing having a distal end, a tab disposed on the distal end for engaging a clamp, an engagement surface fixedly positioned relative to the tab for engaging the clamp to release the clamp from an open position and allow the clamp to shift to a closed position, and a sensor that detects the shifting of the clamp.” Schneider ‘802 does not disclose a hose clamp installation tool as claimed. For example, Schneider ‘802 does not disclose an engagement surface that is fixedly positioned relative to a tab that engages a clamp to release the clamp from an open position. In the final Office Action, the Examiner called axial rod 42 an engagement surface and called hooked portion 43 a tab (see final Office Action, page 2). Axial rod 42 cannot properly be considered an engagement surface as claimed since it does not engage the clamp to release the clamp from an open position. Instead, Schneider ‘802 discloses that a sleeve 40 is extended to engage and release a clamp. More specifically, trigger mechanism 48 is “activated to extend sleeve 40 and urge sleeve 40 into engagement with tapered arm 29” of clamp 20. When “sufficient force is applied by trigger mechanism 48 to sleeve 40 to disengage tab 32 [of the clamp] from engagement with cross bar 27 [of the clamp], tapered arm 29 will spring back away from cross bar 27 with a quick movement away from sleeve 40” (see column 6, lines 5-6 and 9-13). In other words, sleeve 40 moves relative to axial rod 42 and hooked portion 43 to engage and release the clamp from an open position. Moreover, sleeve 40 cannot properly be considered an engagement surface as claimed since it is not fixedly positioned relative to the hook portion 43. Thus, Schneider ‘802 does not explicitly disclose an engagement surface as recited in claim 1. Furthermore, the Examiner has not argued that the limitations of claim 1 are

inherently disclosed in Schneider '802. For these reasons, a *prima facie* case has not been established and the rejection of claim 1 must be reversed.

A *prima facie* case has not been established for the rejection of independent claim 15. Claim 15 recites a hose clamp installation tool. The tool includes "a housing having a distal end, an arm disposed on the distal end, the arm including a tab and an engagement surface disposed adjacent to the tab, the engagement surface being adapted to contact the clamp to release the clamp from an open position and allow the clamp to shift to a closed position, and a sensor for providing a signal indicative of the shifting of the clamp from the open position to the closed position." Schneider '802 does not disclose a hose clamp installation tool as claimed. In the final Office Action, the Examiner rejected this claim without pointing out where all of the claim limitations are found in the prior art relied upon in the rejection. In particular, the Examiner failed to address the requirement of an "arm including a tab and an engagement surface disposed adjacent to the tab, the engagement surface being adapted to contact the clamp to release the clamp from an open position and allow the clamp to shift to a closed position." Regardless of this oversight, Schneider '802 does not disclose any structure that could properly be considered an arm as claimed. In particular, the axial rod 42 having a hooked portion 43 cannot properly be considered an arm since it does not have an engagement surface that contacts the clamp to release the clamp from an open position to allow the clamp to shift to a closed position. Rather, Schneider '802 discloses that a sleeve 40 disengages tab 32 from engagement with cross bar 27 to cause tapered arm 29 to "spring back away from cross bar 27" (see column 6, lines 8-12). The sleeve 40 is not an arm since it does not include a tab and an engagement surface disposed adjacent to the tab as recited in claim 15. Thus, Schneider '802 does not explicitly disclose each and every element of claim 15. Furthermore, the Examiner has not argued that the limitations of claim 15 are inherently disclosed in Schneider '802. For these reasons, a *prima facie* case has not been established and the rejection of claim 15 must be reversed. Since claims 16, 18 and 19 depend on claim 15, the rejection of these claims must be reversed for the same reasons.

**B. Claim 2 is Patentable Under 35 U.S.C. § 103(a)
Over U.S. Patent No. 5,907,802 issued to Schneider in view of
U.S. Patent No. 5,615,575 issued to Goodwin**

Claim 2 depends on claim 1. Therefore, Applicants believe the rejection of this claim must be reversed for the reasons previously discussed.


CONCLUSION

Schneider '802 does not disclose all the limitations recited in claims 1, 2, 15, 16, 18 and 19. Therefore, the final rejection of these claims should be reversed.

The Commissioner is hereby authorized to charge the Appeal Brief fee of \$500, as applicable under the provisions of 37 C.F.R. § 41.20(b)(2), and any other fee deficiency incurred as a result of the filing of this paper, to the deposit account of Ford Global Technologies LLC, Deposit Account No. 06-1510. A duplicate copy of this page is enclosed for that purpose.

Respectfully submitted,

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Enclosure - Appendices



VIII. CLAIMS APPENDIX

1. A hose clamp installation tool comprising:
 - a housing having a distal end;
 - a tab disposed on the distal end for engaging a clamp;
 - an engagement surface fixedly positioned relative to the tab for engaging the clamp to release the clamp from an open position and allow the clamp to shift to a closed position; and
 - a sensor that detects the shifting of the clamp.
2. The hose clamp installation tool of claim 1 wherein the sensor is a load cell.
15. A hose clamp installation tool comprising:
 - a housing having a distal end;
 - an arm disposed on the distal end, the arm including a tab and an engagement surface disposed adjacent to the tab, the engagement surface being adapted to contact the clamp to release the clamp from an open position and allow the clamp to shift to a closed position; and
 - a sensor for providing a signal indicative of the shifting of the clamp from the open position to the closed position.
16. The hose clamp installation tool of claim 15 wherein the tab includes at least one beveled side that facilitates engagement of the tab and the clamp.
18. The hose clamp installation tool of claim 15 further comprising a power source for providing power to the sensor.

19. The hose clamp installation tool of claim 15 further comprising an output device for providing information to an operator based on the signal from the sensor.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None